

## REMARKS

In the March 11, 2004 Office Action, the Examiner noted that claims 14-26 were pending in the application; allowed claims 22-25, rejected claims 14, 18 and 20 under the first paragraph of 35 U.S.C. § 112; rejected claims 14-16, 18, 20 and 21 under 35 U.S.C. § 102(e); and rejected claims 14-21 and 26 under 35 U.S.C. § 103. In rejecting the claims, U.S. Patents 6,584,118 to Russell et al.; 5,706,285 to Saijonmaa et al.; 6,151,336 to Cheng et al. (References A, B and F, respectively, in the September 11, 2003 Office Action) and 5,606,317 to Cloonan et al. (Reference A in the March 11, 2004 Office Action) were cited. Claims 14-26 remain in the case. The Examiner's rejections are traversed below.

### **Newly Cited Prior Art: U.S. Patent 5,606,317 to Cloonan et al.**

The Cloonan et al. patent is directed to an apparatus for mBnB coding and decoding with efficient bandwidth utilization. Specifically, Cloonan et al. discloses 8B/9B encoding at column 8, lines 30, et seq.

### **Rejection under 35 U.S.C. § 112, First Paragraph**

In item 2 on page 2 of the Office Action, claims 14, 18 and 20 were rejected under the first paragraph of 35 U.S.C. § 112 for allegedly failing to comply with the written description requirement by reciting the negative limitation "without frame detection" (e.g., claim 14, line 4). Claims 14, 18 and 20 have been amended to remove the limitations directed to frame detection. Therefore, withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 is respectfully requested.

### **Rejection under 35 U.S.C. § 102(e)**

In item 5 on pages 3-5 of the Office Action, claims 14-16, 18, 20 and 21 were rejected under 35 U.S.C. § 102(e) as anticipated by Russell et al. As discussed at the bottom of page 5 of the Amendment filed by certificate of mail on December 11, 2003 (received by the U.S. Patent and Trademark Office on December 15, 2003), the rate adaptation in Russell et al. is performed by first identifying boundaries of packet data frames and extracting packet data frames from the synchronous bit stream, before decoding packet data frames to release Ethernet data frames (see Fig. 7 of Russell et al.). Claims 14, 18 and 20 have been amended to recite

a decoder receiving an Ethernet signal and performing data rate reduction of the Ethernet signal to generate a decoded parallel output; [and]

a first multiplexer, coupled to said decoder to receive the decoded parallel output, adding only one bit to the decoded parallel output to indicate one of data and monitoring information in the parallel decoded output

(e.g., claim 14, lines 3-7), as described in paragraph [0017] of the Substitute Specification. Since the Ethernet signal is received by the decoder, there is no frame detection prior decoding, as taught by Russell et al. Thus, the present invention is able to provide a benefit over Russell et al. of not requiring frame detection.

For the above reasons it is submitted that claims 14, 18 and 20, as well as claims 15, 16 and 21 which depend therefrom, patentably distinguish over Russell et al.

### **Rejection under 35 U.S.C. § 103**

In item 7 on pages 5-8 of the Office Action, claims 14-16, 18, 20 and 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saijonmaa et al. in view of Russell et al. It is submitted that Saijonmaa et al. would not suggest to one of ordinary skill in the art any modification of Russell et al. that would overcome the deficiencies discussed above. Therefore, it is submitted that claims 14-16, 18, 20 and 21 patentably distinguish over Saijonmaa et al. in view of Russell et al. for the reasons discussed above.

In item 8 on pages 9-10 of the Office Action, claims 17 and 26 were rejected over Russell et al. in view of Cloonan et al. Claims 17 and 26 recite that the signals recovered are "encoded 8B/9B signals" in accordance with the embodiment described on page 4 of the application. Nothing has been cited or found in either Russell et al. or Cloonan et al. teaching or suggesting modification of the system disclosed in Russell et al. to add the ability to recover encoded 8B/9B signals as disclosed in Cloonan et al. Thus, these two references merely provide a mosaic of teachings of the features recited in claims 17 and 26 without any reason for a person of ordinary skill in the art to combine the teachings to meet the limitations recited in the claims. Therefore, it is submitted that claims 17 and 26 patentably distinguish over Russell et al. in view of Cloonan et al.

In item 9 on pages 10-11 of the Office Action, claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over Russell et al. in view of Cheng et al. Nothing was cited or has been found in Cheng et al. overcoming the deficiencies of Russell et al. noted above. Since claim 19 depends from claim 18, it is submitted that claim 19 patentably distinguishes over Russell et al. in view of Cheng et al. for the reasons discussed above.

**Summary**

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 14-26 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 7/12/04

By: Richard A. Gollhofer  
Richard A. Gollhofer  
Registration No. 31,106

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501